



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,267	12/03/2001	Emil C. Gotschlich	040853-01-5029-02	8278
28977	7590	11/05/2003	EXAMINER	
MORGAN, LEWIS & BOCKIUS LLP 1701 MARKET STREET PHILADELPHIA, PA 19103-2921			RAO, MANJUNATH N	
			ART UNIT	PAPER NUMBER

1652

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/007,267

Applicant(s)

GOTSCHLICH, EMIL C.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-39 and 50-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-39 and 50-57 is/are allowed.
- 6) ☒ Claim(s) 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of.
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-101)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 34-39, 50-58 are currently pending and are present for examination.

Applicants' amendments and arguments filed on 9-2-03 have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

### ***Specification***

Examiner has withdrawn the previous objection to specification under 35 U.S.C. 132 -- which states that no amendment shall introduce new matter into the disclosure of the invention--, that the amendment filed on 3-13-03, paper No. 7 introduces new matter into the disclosure. Examiner has withdrawn the objection as applicants have explained the reasons for such amendments and provided exhibits to support their arguments.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1652

Claim 58 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2(d) of U.S. Patent No. 5705367. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim, because the examined claim is either anticipated by, or would have been obvious over the reference claim. See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi* 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 58 of the instant application and claims 29(d) of the reference patent are both directed to a method of making oligosaccharide having the structure

GalNAc $\beta$ 1 $\rightarrow$ 3Gal $\beta$ 1 $\rightarrow$ 4GlcNAc $\beta$ 1 $\rightarrow$ 3Gal $\beta$ 1 $\rightarrow$ 4Glc, said method comprising contacting a reaction mixture comprising an activated GalNAc to an acceptor moiety comprising Gal $\beta$ 1 $\rightarrow$ 4GlcNAc $\beta$ 1 $\rightarrow$ 3Gal $\beta$ 1 $\rightarrow$ 4Glc residue in the presence of a glycosyltransferase with amino acid sequence SEQ ID NO:5 which is identical to the claim 2(d).

The portion of the specification (and the claims) in the reference patent that supports the recited method using the amino acid sequence SEQ ID NO:5 would anticipate the method claimed in claim 58 herein using the polypeptide of claim 37 which is SEQ ID NO:5. Claim 58 of the instant application listed above cannot be considered patentably distinct over claim 2(d) of the reference patent when there is specifically recited embodiment that would anticipate mainly claim 58 of the instant application. Alternatively, claim 58 cannot be considered patentably distinct over claims 2(d) of the reference patent when there is specifically disclosed embodiment in the reference patent that supports claim 2(d) of that patent and falls within the scope of claim

Art Unit: 1652

58 herein because it would have been obvious to one having ordinary skill in the art to modify claim 2 of the reference by selecting a specifically disclosed embodiment that supports that claim. i.e., a method of making oligosaccharide having the structure GalNAc $\beta$ 1 $\rightarrow$ 3Gal $\beta$ 1 $\rightarrow$ 4GlcNAc $\beta$ 1 $\rightarrow$ 3Gal $\beta$ 1 $\rightarrow$ 4Glc, said method comprising contacting a reaction mixture comprising an activated GalNAc to an acceptor moiety comprising Gal $\beta$ 1 $\rightarrow$ 4GlcNAc $\beta$ 1 $\rightarrow$ 3Gal $\beta$ 1 $\rightarrow$ 4Glc residue in the presence of a glycosyltransferase with amino acid sequence SEQ ID NO:5. One of ordinary skill in the art would have been motivated to do this because that embodiment is disclosed as being one of the preferred embodiment within claim 2 of the reference patent.

### *Conclusion*

Claims 34-39, 50-57 are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

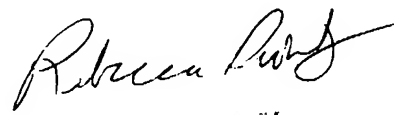
Art Unit: 1652

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

Manjunath N. Rao  
October 31, 2003



RECEIVED  
OCT 31 2003  
1652